REMARKS

Favorable reconsideration and allowance of the claims of the present application, as amended herein, are respectfully requested.

Before addressing the substantative grounds of rejection, Applicants observe that Claims 1 and 12 have been amended in the manner indicated above. Specifically, the subject matter recited in Claim 8 and Claim 16 has been incorporated into Claim 1 and Claim 12, respectively. Furthermore, Claims 8 and 16 have been deleted without prejudice. Applicants submit that the purpose of the above-mentioned claim amendment is solely to advance the prosecution of the present application, and does not represent that Applicants concede the rejections raised in the present Office Action. Furthermore, since the above-mentioned amendments to the claims do not introduce new matter, entry thereof is respectfully requested.

In the Official Action, Claims 1-2, 4, 6, 8, 12-14 and 16 are rejected under 35 U.S.C. §102(b) as allegedly anticipated by the teachings in Ichiroku et al. (US Patent Publication No. 2002/0022681 Al) ("Ichiroku").

In the first place, Applicants submit that the instant rejection to Claims 8 and 16 becomes moot because these claims have been cancelled. With respect to other claims subject to the instant rejection, Applicants submit remarks as set forth below.

Concerning the § 102(b) rejection, it is axiomatic that anticipation under § 102 requires that the prior art reference disclose each and every element of the claim to which it is applied. In re King, 801 F.2d, 1324, 1326, 231 USPQ 136, 138 (Fed. Cir. 1986). Thus, there must be no differences between the subject matter of the claim and the disclosure of the prior art reference. Id. Stated another way, the reference must contain within its four corners adequate direction to practice the invention as claimed. The corollary of the rule is equally applicable:

absence from the applied reference of any claimed element negates anticipation. Kloster Speedsteel AB v. Crucible Inc., 793 F.2d 1565, 1571, 230 USPQ 81, 84 (Fed. Cir. 1986).

Applicants submit that the claims of the present application, as amended herein, are not anticipated by the disclosure of Ichiroku since the applied reference does not disclose the presently claimed composition consisting essentially of three components, which are (a) an epoxy resin selected from the group consisting of bisphenol A epoxy resin, bisphenol F epoxy resin, an aliphatic epoxy resin, and a cycloaliphatic epoxy resin, and a mixture thereof, and (b) a curing agent selected from acid anhydrides, and (c) a promoter selected from the group consisting of the quaternary ammonium salts, imidazole compounds, and salts of 1,8-diazabicyclo[5,4,0]-undec-7-ene, and a mixture thereof, wherein the mixing ratio by weight of said epoxy resin to said curing agent is in the range of from 0.7 to 1.1. In this regard, Applicants observe that the term "consisting essentially of" limits the scope of a claim to the specified materials or steps "and those that do not materially affect the basic and novel characteristic(s)" of the claimed invention. *In re Herz*, 537 F.2d 549, 551-52, 190 USPQ 461, 463 (CCPA 1976) (emphasis in original).

Regarding Ichiroku, Applicants submit that this cited reference teaches an epoxy resin composition comprising (a) an epoxy resin; (b) a curing agent; (c) a silicone stress-reducing agent; and (d) a foam suppressing composition. Said foam suppressing composition comprises hydrophobic organopolysiloxane and hydrophilic polyoxyalkylene modified silicone oil. The presence of the foam suppressing composition affects the novel and basic characteristics of the composition of the present invention. See Abstract and page 9, paragraph [0013].

It is to be noted that these additional components, viz., hydrophobic organopolysiloxane, and hydrophilic polyoxyalkylene modified silicone oil are essential

components of Ichioroku and distinguish the composition described therein from other epoxy resin compositions. Thus, Ichiroku requires this additional foam suppressing composition in its epoxy resin composition. It does not describe or teach a material composition without such component which provides the advantages of a high glass transition temperature, low refractive index, high light transmission and scratch resistance, as in the present invention. The foam suppressing composition is thereby excluded from the composition of the present invention by the use of the term "consisting essentially of", as the addition of the hydrophobic organopolysiloxane and hydrophilic polyoxyalkylene modified silicone oil of Ichioroku in the present composition imparts properties thereto which affects the novel and basic characteristics of the composition of the present invention. Therefore, the rejection of Claims 1-2, 4, 6, and 12-14 under 35 U.S.C. §102(b) is obviated; withdrawal thereof is respectfully requested.

Further, Claims 1-2, 4, 6, 8, 12-14 and 16 are rejected under 35 U.S.C. 102(b) as allegedly anticipated by the teachings in Wada et al. (US Patent No. 5,145,889) ("Wada").

In the first place, Applicants submit that the instant rejection to Claims 8 and 16 becomes moot because these claims have been cancelled. With respect to other claims subject to the instant rejection, Applicants submit remarks as set forth below.

Applicants submit that the above remarks regarding the subject matter of the presently amended claims, the present US patent law concerning the § 102(b) rejection, and the term "consisting essentially of" are equally applicable to the instant rejection, and therefore are incorporated by reference. With respect to Wada, Applicants submit that it teaches a composition comprising five components, which are (a) an epoxy resin; (b) a curing agent; (c) a curing accelerator including an onium or diazabicycloalkene salt; (d) a phosphorus triphosphite; and (e) a silane coupling agent. See column 12, lines 13-24.

It is clear that Wada discloses that this silane coupling agent and the phosphorous triphosphite are essential components of Wada and imparts properties that distinguish it from other epoxy resin compositions. The presence of these additional ingredients in the present claimed composition affects the basic and novel properties of the present claimed composition and thus the additional ingredients are excluded from the present invention by the term "consisting essentially of", as Wada does not teach or describe a packaging composition having a high glass transition temperature, low refractive index, high light transmission and scratch resistance without either one of these components. Thus, this rejection of Claims 1-2, 4, 6, and 12-14 under 35 U.S.C. §102(b) is obviated; withdrawal thereof is respectfully requested.

Further, Claims 1-2, 4, 6, 8, 12-14 and 16 are rejected under 35 U.S.C. 102(e) as allegedly anticipated by the teachings of two published applications by Sumita et al., viz. US Patent Publication No. 2002/0077421 (i.e., '421), and US Patent Publication No. 2002/0089071 (i.e., '071).

In the first place, Applicants submit that the instant rejection to Claims 8 and 16 becomes moot because these claims have been cancelled. With respect to other claims subject to the instant rejection, Applicants submit the remarks as set forth below.

Applicants respectfully submit that the above remarks regarding the subject matter of the presently amended claims, the present US patent law concerning the § 102(b) rejection, and the term "consisting essentially of" are equally applicable to the instant rejection, and therefore are incorporated into here by reference.

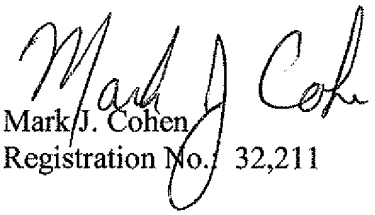
Furthermore, Applicants submit that both the '421 and the '071 publications disclose a liquid epoxy resin, a curing agent, a curing accelerator and an inorganic filler as essential components. The '071 publication requires acrylic particles of core-shell structure

formed from polymers or copolymers comprising an alkyl acrylate or alkyl methacrylate or both and it is this acrylic component which is the distinguishing feature and makes the composition different from other compositions. On the other hand, the '421 publication requires the presence of a curing agent comprising 5 to 75 parts by weight of a mixture of 3,4-dimethy-6-(2-methyl-1-1-propenyl)-1,2,3,6, tetrahydrophthalic acid and 1-isopropyl-4-methyl bicyclo [2.2.2] oct-5-ene-2,3 dicarboxylic acid ("mixture") distinguishing the curing agent from other curing agents. Thus, it is the distinguishing feature of the composition described in the '421 publication and thus is required. Consequently, the presence of these acrylic components and the dicarboxylic acid and tetrahydrophthalic acid in the present composition affects the basic and novel properties of the present invention. Both the mixture of tetrahydrophthalic acid and the mixture of dicarboxylic acid and the acrylic particles are excluded from the present invention through the use of "consisting essentially of". Neither the '421 publication nor the '071 publication teach or disclose a packaging composition of the present invention which provides high glass transition temperatures, low retractive index, high light transmission and scratch resistance in the absence of the acrylic component or the mixture described hereinabove . Thus, the rejections of claims 1-2, 4, 6, and 12-14 under 35 U.S.C. §102(e) by either the '071 or the '421 publications are obviated; withdrawal thereof is respectfully requested.

Furthermore, Applicants have incorporated the amendments to claim 1 into the claims that have been withdrawn. Consequently, the scope of the material compositions in the withdrawn claims is the same as that which is recited in the claims being examined. In view of these amendments, Applicants respectfully request rejoining the prior withdrawn claims.

In view of the foregoing amendments and remarks, it is firmly believed that the subject application is in condition for allowance, which action is earnestly solicited.

Respectfully submitted,



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